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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Application of :
David G. Bird : Group Art Unit: 3662
Serial No.: 08/862,039 : Examiner: Blum, T.
Filed: May 22, 1997 :
For: LOCATION OF MISSING : Appeal No.: 2002-0393
VEHICLES
Reissue of Original Patent :
No. 5,418,537 issued May 23, 1995

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William E. Pelton September 22, 2004
William E. Pelton Date
Reg. No. 25,702

APPELLANT'S REPLY TO THE SUPPLEMENTAL
EXAMINER'S ANSWER OF JULY 22, 2004

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

On July 31, 2003 the Board remanded the application identified above to the examiner for appropriate action with respect to reissue claims 28 to 59 in light of the Board's precedential opinion in Ex parte Eggert, 67 U.S.P.Q.2d 1716 (BdPatApp & Int 2003). On July 22, 2004 an Office Action

constituting the examiner's supplemental answer on remand was mailed to the appellant. In the July 22, 2004 Office Action the examiner reconfirmed the rejection of claims 28 to 59 on the grounds that, notwithstanding Ex parte Eggert, claims 28 to 59 are not patentable because of alleged impermissible recapture. Appellant files this reply pursuant to 37 C.F.R. §1.193(b)(1) in which the examiner's position is respectfully traversed.

The examiner's position is, in effect, that applicant's failure to limit the original claims to the patentable features of (1) a non-cellular paging request responder and (2) a communication device capable of operation independent of the paging request responder, is not correctable error under 35 U.S.C. §251 when claim features previously introduced by amendment are allegedly eliminated from the reissue claims. The examiner has focused entirely on amendments during prosecution narrowing original application claims to features characterized as (1) "a specific receiver/processor" and (2) activation of communication devices "only when the receiver on the vehicle receives a request signal." The examiner argues that these features were required for patentability in the original application, and therefore in reissue appellant cannot retreat from those limitations. Relying on In re Clement, 131 F.3d 1464, 45 U.S.P.Q.2d 1161 (CAFC 1997), the examiner seeks a ruling that no aspect of the invention purportedly surrendered during prosecution can be recovered on reissue.

This restrictive interpretation of In re Clement was not adopted by the Board in Ex parte Eggert. In Ex parte Eggert the Board recognized and confirmed that to avoid recapture, a reissue claim need not have "each and every limitation added to a claim or argued by applicant during the prosecution of the original patent application..." Ex parte Eggert, 67 U.S.P.Q.2d at 1723. With reference to the Venn "Drawing 1" set forth in Ex parte Eggert the Board said:

For example, if an outer circle claim contains elements ABC
and the inner circle claim contains elements ABCDEF, a reissue

application cannot recapture a claim directed to elements ABC (outer circle) or a claim entirely outside the outer circle (e.g., AB, BC, ABC_{BR}, etc.). However, it is our view that the reissue capture rule is not invoked for claims directed to elements ABCX, ABCD_{BR}, ABCEF, A_{BR}BCDEF.

Ex parte Eggert, 57 U.S.P.Q.2d at 1718.

Even if some features of appellant's reissue claims incorporate subject matter previously surrendered, appellant's reissue claims 28 to 59 reduce to "ABCX," where "X" equals the new patentable features of (1) a non-cellular paging request responder and (2) communication devices operating independently of the paging request responder. According to Ex parte Eggert therefore the reissue recapture rule should not be invoked for appellant's claims 28 to 59.

This is simply a case where the original claim drafter erred by failing to foresee that limiting the claims to the features of (1) a non-cellular paging request responder and (2) communication devices operating independently of the paging request responder would encompass non-obvious embodiments. In Eggert the Board cited In re Richman, 409 F.2d 269 (CCPA 1969) in confirming that such an error has been explicitly recognized as correctable. The Board quoted In re Richman as follows:

Certainly one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art.

In re Richman, 409 F.2d at 274-75; Ex parte Eggert, 67 U.S.P.Q.2d at 1723.

The correct analysis to be followed here was followed by the Court of Appeals for the Federal Circuit in Hester Industries Inc. v. Stein. Inc., 142 F.3d 1472, 46 U.S.P.Q.2d 1641 (CAFC 1998), also cited with approval by the Board in Eggert. In re Eggert, 67 U.S.P.Q.2d at 1726-1727. In Hester the Federal Circuit stated that even where surrendered subject matter has “crept back” into the reissue claims, the court should “consider whether the reissue claims were materially narrowed in other respects.” Hester Industries Inc. v. Stein Inc., 142 F.3d at 1482, 46 U.S.P.Q.2d at 1649. While in Hester the Court concluded that the reissue claims at issue in that case had not been materially narrowed, and that the narrowing limitations had not been overlooked, it is clear from Hester that the addition of materially narrower limitations relating to overlooked subject matter can overcome the recapture rule. Hester Industries Inc. v. Stein Inc., 142 F.3d at 1482-1483, 46 U.S.P.Q.2d at 1649-1650. This principle was cited with approval by the Board in Ex parte Eggert. Ex parte Eggert, 67 U.S.P.Q.2d at 1727.

Here it is undisputed that the material limitations set forth in appellant’s reissue claims are narrowing amendments that represent aspects of appellant’s invention that were overlooked during prosecution of the original patent. The examiner has admitted that:

At no time were claims present in the parent application which (1)
called for a communication device capable of operation independent
of a paging request responder, or (2) call for a noncellular paging
request responder,

and that “The reissue claims are, however, limited by the limitations of C2 and C3.”¹ Indeed the examiner has stated that “the reissue claims are limited solely to a communication device capable of

¹ In “C2” the examiner said that added reissue claims 28-49, 54-55 and 58-59 all call for a communication device capable of operation independent of a paging request responder, and in “C3” the examiner said that added reissue claims 50-53 and 56-57 all call for a non-cellular paging request responder.

operation independent of a paging request responder or a non-cellular paging request responder." It follows that the overall scope of appellant's reissue claims is limited by these fundamentally narrow features that encompass patentable embodiments and were never present in the original or patented claims. That these limitations were overlooked and are material is not in doubt, since they alone are responsible for the patentable distinction of the reissue claims over the cited prior art. The reissue claims do not require for patentability the features of previously amended claims that may have given rise to their allowability, and encompass non-obvious embodiments of the invention that are not covered by the prior claims.

The examiner contends that Ex parte Eggert is not applicable to the facts of this appeal because the reissue claims at issue there were broader in aspects unrelated to the rejections, and only narrower in an aspect germane to the rejection. Relying upon In re Clement the examiner contends that, in contrast, appellant's reissue claims are broader in aspects related to the rejections and narrower in aspects completely unrelated to the rejection, so that the recapture rule applies to appellant. Thus, the examiner contends, for example, that the limitation to a "specific receiver/processor" is entirely missing from the reissue claims, thereby broadening those claims in an aspect germane to a rejection. But reissue claims 28-59 are narrower in aspects directly related (not completely unrelated) to what may have been surrendered.

The Office Action in the original application mailed February 8, 1993, rejected claims 1-28 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The examiner stated in support of the rejection that the terms "receiver/processor," "modem/controller" and "vehicle location service or paging service" are indefinite.

In responding to that Office Action, applicant stated in an amendment received by the relevant USPTO examining group on June 22, 1993, that the terms "receiver/processor" and "controller/modem" are proper terms, well understood by those skilled in the art. The applicant further noted that the term "receiver/processor" is a generic term that includes GPS and LORAN as species and that the term "controller/modem" is a generic term for a structure that interrogates location determination systems such as GPS, GLONASS, gyroscopes or local magnetic field sensors and causes a communication system to transmit location. Applicant also stated that the term "vehicle location or paging service" refers to a central station. The terms to which the examiner objected were retained in the claims and the claims were amended to identify a number of other possible sensors as species of a "receiver/processor." The recited sensors did not result in allowance of the claims and there is no indication that they were important to patentability.

Reissue claims 28-59 eliminate the various species of "receiver/processor" but recite the original generic concepts more narrowly, variously reciting performing in-vehicle processing of signals to obtain a fix of vehicle locations, activating a communications device separate from and for operation independent of the paging request responder to transmit a fix of vehicle location in response to a paging request, or activating a cellular communications device mounted in or on the vehicle to transmit a fix of vehicle location. This language is broader than the patent claims but narrower than the original claims in an aspect directly related to features "A" and "B" cited by the examiner in the supplemental answer on remand.

Eggert makes it clear that there is no *per se* rule barring applicant from reentering the shaded area of "Drawing 1." The reissue claims on appeal occupy the shaded area of "Drawing 1" and all recite features narrower in scope than the rejected claims in an aspect directly related to the §112 rejections. Accordingly, the reissue claims on appeal do not fit within the Clement

category to which the examiner refers and are patentable in accordance with the established law, including Eggert. The language of Clement cited by the examiner is inapplicable to the facts of this appeal and affords no basis for application of the recapture rule.

Finally, the examiner misreads In re Clement. The examiner states that “In view of In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), if a reissue claim is broader in an aspect germane to what was surrendered in response to a prior art rejection, but narrower in another aspect completely unrelated to what was surrendered, the recapture rule bars the claim.” But this was not the fact pattern the Court dealt with in Clement. In Clement, as the Board noted in Eggert, “reissue claim 49 was both broader and narrower in areas relevant to the prior art rejections..” In re Clement, 131 F.3d at 1470, 45 U.S.P.Q.2d at 1165. However, in Clement the narrowing limitation of reissue claim 49 relating to the brightness of the pulp (“59 ISO”) was also contained in claim 1 of the issued patent. Accordingly, that narrowing limitation cannot be said to have been an overlooked aspect of the invention, in contrast to the narrowing limitations identified by the examiner as “A” and “B” in the present case. The present case falls within the exception to the recapture rule set forth in Hester, where the Federal Circuit recognized that the recapture rule may be overcome “when the reissue claims are materially narrower in other overlooked aspects of the invention” and that “[T]he purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects.” Hester Industries Inc. v. Stein Inc., 142 F.3d at 1482-1483, 46 U.S.P.Q.2d at 1649-1650.

In summary, the current law permits reissue of an otherwise patentable claim where previously narrowed aspects of the invention are broadened and the claim contains a material narrowing limitation that had been overlooked during the prior prosecution. The rejection of reissue claims 28-59 on the ground of impermissible recapture should be reversed.

Dated: September 22, 2004

Respectfully submitted,

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